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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,150	12/15/2003	Osamu Nagai	13712	3663

7590 05/04/2006
ORUM & ROTH
53 W. JACKSON BLVD
CHICAGO, IL 60604

EXAMINER

BURCH, MELODY M

ART UNIT PAPER NUMBER

3683

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/736,150	Applicant(s) NAGAI, OSAMU	
	Examiner Melody M. Burch	Art Unit 3683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re: claims 1, 2, 13, and 14. The phrase "substantially exclusively" first recited in lines 3-4 of claim 1. Exclusive is defined by Webster's Collegiate Dictionary 10th Edition as "whole, undivided". Substantial, on the other hand, is defined by Webster's Collegiate Dictionary 10th Edition as "being largely but not wholly that which is specified." Examiner maintains that in light of the definitions the phrase "substantially exclusively" is oxymoronic. Clarification is required.

The remaining claims are indefinite as being dependent from claims 1, 2, 13, and 14.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5797594 to Sekine et al. in view of JP-6441495 (JP'495).

Re: claims 1, 2, 13, and 14. Sekine et al. show in figure 1 a hydraulic shock absorbing apparatus of a vehicle comprising: a compression side damping force generating structure for mainly generating a compression side damping force is provided in one hydraulic shock absorber, the one hydraulic shock absorber having a vehicle body side tube 2 and a wheel side tube shown surrounding tube 2 near the bottom of tube 2 which are slidably fitted to each other; a damper having a damper cylinder 8,11 and 8,11,19 in another perspective and a piston rod 18 in which a piston slidable within the damper cylinder is mountable to a leading end portion thereof, and structured such that the damper cylinder is mountable to an inner side of the wheel side tube via intermediate element 3 and the piston rod is mountable to an inner side of the vehicle body side tube via intervening element 9; a piston rod side oil chamber 8a and a piston side oil chamber 8b sectioned within the damper cylinder by the piston, an oil reservoir chamber 10 disposed in an outer periphery of the damper cylinder; and two oil passages 20,21 provided in the piston, a compression side damping valve 23 being provided in one oil passage, and a check valve 22 closing during compression and opening during expansion being provided in the other oil passage, and wherein a volume compensating oil passage 14 communicating the piston rod side oil chamber with the oil reservoir chamber is provided as recited in col. 8 lines 62-67.

Sekine et al. describe the invention substantially as set forth above, but is silent as to having one of the shock absorbers at right and left sides of a wheel with an

expansion side damping force generating structure for mainly generating an expansion side damping force being provided in another hydraulic shock absorber.

JP'495 teaches in pgs 1-2 of the description of the related art section of the instant specification the use of having shock absorbers at both sides of a wheel with one absorber providing the expansion side damping force generating apparatus and the other of the other of the absorbers providing the compression side damping force generating apparatus.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the shock absorber arrangement of Sekine et al. to have included one of the shock absorbers on both sides of a wheel, as taught by JP'495, in order to provide a means of effectively damping both expansion and compression strokes for a wheel to improve the feel of the ride.

Re: claims 3 and 4. Sekine et al., as modified, teach in figure 2 of Sekine et al. the limitation wherein a bypass oil passage 44 communicating the oil chambers in both sides of the piston is disposed in the piston rod of each of the hydraulic shock absorbers, and a damping force adjusting valve 28a is disposed in the bypass oil passage.

Re: claims 5-8. Sekine et al., as modified, teach in figure 2 of Sekine et al. the limitation wherein the oil passage 19 of the one hydraulic shock absorber is disposed in a side wall 19 in the other perspective of the damper cylinder.

Re: claims 9-12. Sekine et al., as modified, teach in figure 2 of Sekine et al. the limitation wherein the oil passage 19 for compensating the volume of the respective

piston rod of the one hydraulic shock absorber is disposed in a guide member 19 for guiding the piston rod 18.

Response to Arguments

5. Applicant's arguments filed 2/14/06 have been fully considered but they are not persuasive. As best understood, the compression side damping force generating structure of Sekine et al., as modified, is capable of generating substantially exclusively a compression side damping force by virtue of it being a compression side damping force generating structure. A similar argument holds true for the expansion side damping force generating structure. Also, as best understood, one of the shock absorbers of Sekine et al., as modified, is arranged to damp substantially exclusively during compression by virtue of being provided with a compression side damping valve. In other words, it is because of the presence of the compression side damping valve that the compression phase is marked substantially exclusively by damping. A similar argument exists for the limitation of the other of the shock absorbers being arranged to damp substantially exclusively during expansion.

The arguments with respect to the volume compensating oil passage are moot in view of the new interpretation of the Sekine reference prompted by Applicant's amendments.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 571-272-7114. The examiner can normally be reached on Monday-Friday (6:30 AM-3:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James McClellan can be reached on 571-272-6786. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3683

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mmb
May 3, 2006

Melody M. Burch
Melody M. Burch
Primary Examiner
Art Unit 3683
5/3/06